

REMARKS

Claims 1-18, 20-56, 58-61, and 64-75 are pending in the present application.

The objection to Claims 19, 62, and 63 is obviated by amendment. Applicants canceled these claims, thus rendering this objection moot. Withdrawal of this ground of objection is requested.

The objection to Claims 1-14, 18, 19, 42-56, 61-63, 67, and 69-74 is obviated by amendment. Applicants have amended the claims to use the Examiner's suggested term "pharmaceutically acceptable salts thereof". Withdrawal of this ground of objection is requested.

The rejection of Claims 1-14, 18, 19, 42-56, 61-63, 67, and 69-74 under 35 U.S.C. 112, second paragraph, is traversed in part and obviated in part by amendment.

Applicants have amended Claims 15, 21, 42, and 58 to remove the "preferably" language. Applicants have also amended Claims 56 and 69 to delete the expression "an alkyl radical selected from". Thus, these criticisms are believed to be moot.

In the Office Action, the Examiner states:

In claim 70, applicant recites the limitation wherein "R¹⁰ may be condensed with a mono- or polycyclic ring system, then recites limitations for said substituent wherein "R¹⁰ may be condensed with an optionally at least monosubstituted aryl- or heteroaryl radical", which is the narrower statement of the range/limitation. The same analysis is applied towards substituents R¹¹⁻¹⁴, etc. Please amend appropriately throughout.

The Examiner is reminded that the proper analysis of definiteness is not that the Examiner's poor understanding trumps that which the skilled artisan would understand. MPEP §2173.02 states that definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and

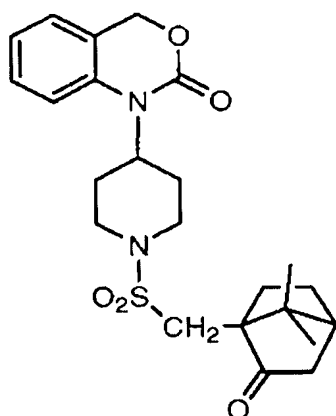
(C) The claim interpretation that would be given by one possessing the ordinary level

Applicants submit that the claims as written are clear and the artisan would readily appreciate the scope and meaning of the claims since the expression "at least mono-substituted aryl- or heteroaryl radical" does not refer to a possible radical to be condensed to R^{10} but to R^{10} in itself. In other words, R^{10} represents hydrogen, an aliphatic radical, a cycloaliphatic radical, or an aryl- or heteroaryl radical, wherein each of these radicals has certain characteristics (e.g. the cycloaliphatic, aryl or heteroaryl radical may be condensed with an optionally at least mono-substituted mono- or polycyclic ring-system). The same is true for each of R^{11-14} . Accordingly, Applicants submit that the claims comply with 35 U.S.C. §112, and no further amendment is necessary.

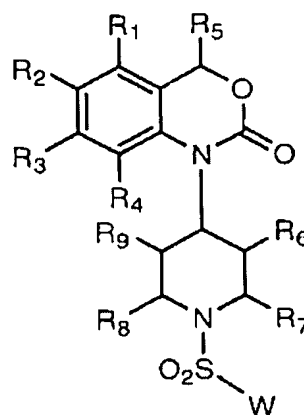
Withdrawal of this ground of rejection is requested.

The rejections of Claims 1-14, 18, 19, 42-56, 61-63, 67, and 69-74 under 35 U.S.C. §103(a) over Bock et al are respectfully traversed.

In making this rejection, the Examiner again cites the compound of Example 10 disclosed by Bock et al at column 30. The Examiner alleges that the claimed invention is obvious based on the analogy ("homology") between a compound of formula (I) in the present application wherein W is a cycloaliphatic radical having a "ethylene" spacer and the example 10 in Bock wherein such spacer is a "methylene" moiety. The structures are as follows:



Example 10 in Bock et al.



Formula (I) in the application

Applicants make no statement with respect to the propriety of the Examiner's allegations and in no way acquiesce to the same and/or the conclusion of obviousness. Solely to expedite examination of this application, Applicants have amended claim 70 to delete the phrase "may be bonded via an optionally at least mono substituted alkylene group and/or" when W represents a cycloaliphatic radical.

Accordingly, Applicants submit that this rejection over Bock et al is moot because this amendment makes it mandatory that when W is a cycloaliphatic radical, it is directly bonded to SO₂, i.e. there would not be a spacer. Consequently, there would not be "homology" between the claimed invention and Bock et al.

Further, Applicants submit that recent case law supports the non-obviousness of the claimed invention. Specifically, the Court of Appeals for the Federal Circuit recent held in *Takeda Chemical Industries Ltd. v. Alphapharm Pty. Ltd.*, 83 USPQ2d 1169 (Fed. Cir. 2007) that in order to find a *prima facie* case of unpatentability, a showing that the "prior art would have suggested making the specific molecular modifications necessary to achieve the claimed invention" was also required (*Takeda* at 1174, citing *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990); *In re Grabiak*, 769 F.2d 729, 226 USPQ 870 (Fed. Cir. 1985); *In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984)). Indeed, the *Takeda* Court further held that "in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish *prima facie* obviousness of a new claimed compound." (*Takeda* at 1174) Since Bock et al fails to suggest making the specific molecular modifications necessary to achieve the claimed invention, the claimed invention would not be obvious.

Withdrawal of these grounds of rejection is requested.

Applicants make no statement with respect to the Examiner's allegation that the proviso added in Claim 70 does not find support in the priority application and in no way acquiesce to the same. Applicants reserve the right to address this issue at a later date if and when the effective filing date and priority become an issue.

With respect to the withdrawn method claims, the Examiner is reminded that if, as in this case, Applicant elects claims directed to the product, and a product claim

is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim should be rejoined (see MPEP §821.04). Applicants note that should the examined product claims be found allowable, withdrawn process claims should be rejoined. An action to this effect is requested.

Applicants submit that the present application is ready for allowance. Early notice to this effect is requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

Norman E. Oblon



Vincent K. Shier, Ph.D.
Registration No. 50,552

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 08/03)